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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,667	03/19/2001	Reem Safadi	D02440-01	9028

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GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM, PA 19044

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/810,667	Applicant(s) SAFADI ET AL.	
	Examiner HUY T. NGUYEN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 and 45-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 21-24 and 45- 60 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11 May 2006.

Applicant's election of claims 1-20 and 25-44 in the reply filed on 11 May 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 6-9, 25-26 and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al (5,758,009).

Regarding claims 1 and 14, Hashimoto discloses a personal versatile recording apparatus (110), Fig. 1) comprising:

means for programming said personal versatile recording apparatus (Fig. 1, column 1, lines 5-13, column 2, lines 43-65)) record a selected event (0016); and

means for recording said selected event, wherein said selected event is recorded in its entirety despite the occurrence of a schedule change or an overrun of the selected event (column 1 lines 50 to column 2, line 15, column 3, line 45 to column 4 line 53) in section 0097, 0016-0018) .

Regarding claim 2, Hashimoto further teaches the means for programming said personal versatile recording apparatus is a user interface (section 0016).

Regarding claim 6, Hashimoto further teaches the personal versatile recording apparatus of claim 1, wherein data produced by an electronic programming guide server is used by said personal versatile recording apparatus to determine the starting time and the ending time for recording said selected event, said data being updated in near-real-time (column 1, lines 5-45) , the user can use time information to set recording start time and end time .

Regarding claim 7, Hashimoto further teaches the recording of said selected event beginning at a first time that is immediately before said starting time and ending at a second time that is immediately after said ending time since the user can control and set the time for recording .

Regarding claim 8, Hashimoto further teaches the personal versatile recording apparatus of claim 7, wherein said first time and said second time being determined in

near-real-time by said updated data produced by said electronic programming guide server (col. 2, lines 1-15).

Regarding claim 9, Hashimoto further teaches the personal versatile recording apparatus of claim 7, wherein the portion of said selected event that has been recorded before said first time and after said second time is deleted from the recording since the user can control erasing any portion of the recorded program .

Method claim 25-26 and 30-33 correspond to apparatus claims 1-2 and 6-9. Therefore method claims 25-26 and 30-33 are rejected by the same reasons as applied to apparatus claims 1-2 and 6-9.

4. Claims 1-9,14,16-17, 25-33 and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Akamasu et al (2003/0106071).

Regarding claims 1 and 14, Akamasu discloses a personal versatile recording apparatus (110), Fig. 1) comprising:

means for programming said personal versatile recording apparatus to record a selected event (0016); and

means for recording said selected event, wherein said selected event is recorded in its entirety despite the occurrence of a schedule change or an overrun of the selected event (section 0097, 0016-0018) .

Regarding claim 2, Akamasu teaches the personal versatile recording apparatus of claim 1, wherein said means for programming said personal versatile recording apparatus is a user interface (section 0016).

Regarding claim 3, Akamasu further teaches that the personal versatile recording apparatus of claim 1, wherein said personal versatile recording apparatus includes means for registering with an electronic programming guide server so that said personal versatile recording apparatus is notified by said electronic programming guide server when said selected event has ended (sections 0097,0017).

Regarding claim 4, Akamasu teaches the personal versatile recording apparatus of claim 3, wherein upon completion of said selected event, said electronic programming guide server sends at least one multicast message to said personal versatile recording apparatus to notify said personal versatile recording apparatus that said selected event has ended.

Regarding claim 5, Akamasu further teaches upon completion of said selected event, said electronic programming guide server broadcasts the end time for said selected event regardless of the time said personal versatile recording apparatus has been instructed to record said selected event (section 0013-1106).

Regarding claim 6, Akamasu further teaches the personal versatile recording apparatus of claim 1, wherein data produced by an electronic programming guide server is used by said personal versatile recording apparatus to determine the starting time and the ending time for recording said selected event, said data being updated in near-real-time (sections 0013-0018).

Regarding claim 7, Akamasu teach the personal versatile recording apparatus of claim 6, wherein:

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the recording of said selected event beginning at a first time that is immediately before said starting time and ending at a second time that is immediately after said ending time (sections 0013-0015).

Regarding claim 8, Akamasu further teaches the personal versatile recording apparatus of claim 7, wherein:

said first time and said second time being determined in near-real-time by said updated data produced by said electronic programming guide server (section 0013- 0017) .

Regarding claim 9, Akamasu further teaches the personal versatile recording apparatus of claim 7, wherein the portion of said selected event that has been recorded before said first time and after said second time is deleted from the recording since the user can control erasing any portion of the recorded program .

Method claim 25-33 correspond to apparatus claims 1-9. Therefore method claims 25-33 are rejected by the same as applied to apparatus claims 1-9.

Regarding claims 16 and 39, Akamasu further teaches the personal versatile recording apparatus of claim 14, wherein said another peripheral device comprises one of an FM tuner, a CD player, a DVD player, and an MP3 player (Fig. 1) .

Method claims 38-39 correspond to apparatus claims 14 and 16 . Therefore method claims 38-39 are rejected by the same reason as applied to apparatus claims 14 and 16.

Regarding claim 17 , Akamasu to disclose a personal versatile recording apparatus comprising:

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a personal recording apparatus programmed to record a selected event and for recording said selected event,
said personal recording apparatus being incorporated into a wireless home network (Fig. 1 sections 0097,0163-0167).

Method claim 40 corresponds to apparatus claim 17 . Therefore method claim 40 is rejected by the same reason as applied to apparatus claim 17.

5. Claims 18 , 20, 42 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (2005/0198214).

Regarding claims 18 and 20 , Inoue discloses a personal versatile recording apparatus comprising:

means for programming said personal versatile recording apparatus to record a selected event (Figs. 1-4) ; and

means for recording said selected event, said selected event is music, said music conforming to a listener profile (section 0299).

Method claims 42 and 44 correspond to apparatus claims 18 and 20. Therefore method claims 42 and 44 are rejected by the same reason as applied to apparatus claims 18 and 20 .

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10- 13 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akamasu in view of Akira (JP 61-17241).

Regarding claims 10-13 , Akamasu does not teach a tag having an event start indication and an event end indication is included within an information stream corresponding to said selected event.

Akira teaches a tag having a having an event start indication and an event end indication is included within an information stream corresponding to said selected event.

It would have been obvious to one of ordinary skill in the art to modify Akamasu with Akira by providing a tag having an event start indication and an event end indication as taught by Akira as an alternative method for controlling recording the event.

Method claims 34-37 correspond to apparatus claims 10-13 Therefore method claims 34-39 are rejected by the same reason as applied to apparatus claims 10-13

8. Claims 15 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akamasu in view of Thomason (6,317,039).

Regarding claims 15 and 41, Akamasu does not teach using a wireless headphone. However it is noted that using a wireless headphone with a network is well

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known in the art as taught by Thomason (Fig. 4) . It would have been obvious to one of ordinary skill in the art to modify Akamasu with Thomason by using a wireless headphone with the system of Akamasu when needed.

9. Claims 19 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of the Official Notice .

Regarding claims 19 and 43, Inoue fails to specifically teach using a compact disk for storing music . However, it is noted that using a compact disk for storing music is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Inoue by using a CD as an alternative to the medium of Inoue for recording music.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N


HUY NGUYEN
PRIMARY EXAMINER